

REMARKS

This Application has been carefully reviewed in light of the Office Action dated May 1, 2008 (the “*Office Action*”). At the time of the *Office Action*, Claims 1-4, 6, and 9-12 were pending and rejected in the Application. Applicants amend Claim 3 and add new Claim 22. Applicants respectfully submit that no new matter is introduced by these amendments. Applicants request reconsideration and favorable action in this case.

Claim Objections

The Examiner rejects Claim 3 due to informalities. Without conceding the veracity of the Examiner’s objections, Applicants have amended Claim 3 to address the Examiner’s concerns. Applicants respectfully request that the objection to Claim 3 be withdrawn.

Section 112 Rejections

The Examiner rejects Claim 1, 2, 4, and 6 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner states that “[i]t is vague and unclear in Claim 1 what or who is “maintaining a predefined macro language,” “retrieving from the registry of keywords,” and “executing the executable code.”” (*Office Action*, pages 2-3). The Examiner questions whether a computer or a user is performing the steps of Claims 1, 2, 4, and 6. (*Office Action*, page 3). Applicants respectfully traverse the rejection of Applicants’ claims on this basis.

Initially, Applicants note that the Examiner has cited no authority for the proposition that, for a claim to be definite and particularly point out and distinctly claim the subject matter of the invention, an applicant must designate in the claim whether a computer or user is performing the recited steps. Applicants submit that there is no such requirement. The M.P.E.P. states that, to meet the statutory requirements of 35 U.S.C. § 112, second paragraph, the claims must (1) set forth the subject matter that Applicants regard as their invention and (2) particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant. (M.P.E.P. § 2171.01). There is no requirement in 35 U.S.C. § 112, second paragraph that Applicants must designate whether the steps of a method claim are performed by a computer or user.

The M.P.E.P. does explicitly state, however, that the breadth of a claim is not to be equated with indefiniteness. (M.P.E.P. § 2173.04, citing *In re Miller*, 441 F.2d 689, 169 U.S.P.Q. 597 (C.C.P.A. 1971). According to the M.P.E.P., “[i]f the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.” (M.P.E.P. § 2173.04). In this case, Applicants respectfully submit that the Examiner has confused the breadth of the claims with indefiniteness. However, Applicants’ claims clearly recite a series of steps to be performed for providing an extensible macro language. The steps are not indefinite in that the claims set forth the subject matter that Applicants’ regard as the invention and particularly point and distinctly define the metes and bounds of the subject matter. The scope of the claims is clear. Applicants have not indicated that Applicants intend the invention to be of a scope different from that defined in the claims. Accordingly, Applicants respectfully submits that Claims 1, 2, 4, and 6 meet the requirements of 35 U.S.C. § 112, second paragraph.

For at least these reasons, Applicants respectfully request that the rejection of Claims 1, 2, 4, and 6 under 35 U.S.C. § 112, second paragraph be withdrawn.

Section 103 Rejections

The Examiner rejects Claims 1, 2, and 9 under 35 U.S.C. § 103(a) as being unpatentable over Alexander Sakharov, “Macro Processing in High-Level Languages” (“*Sakharov*”). The Examiner rejects Claims 3, 4, 6, and 11-21 under 35 U.S.C. § 103(a) as being unpatentable over *Sakharov*, U.S. Patent No. 5,295,059 issued to Brooks et al. (“*Brooks*”), in view of U.S. Patent No. 4,931,928 issued to Greenfeld (“*Greenfeld*”), and further in view of Douglas McIlroy, “Macro Instruction Extensions of Compiler Languages” (“*McIlroy*”) and further in view of U.S. Patent No. 5,737,592 issued to Nguyen et al. (“*Nguyen*”). For the reasons discussed below, Applicants’ respectfully submit that Claims 1-4, 6, 9, and 11-21 are allowable over the Examiner’s proposed combinations.

A. Claims 1, 2, and 9 are patentable over *Sakharov*

Independent Claim 1 of the present Application recites:

A method for providing an extensible macro language comprising:
maintaining a predefined macro language comprising a plurality of keywords and a plurality of associated commands for execution;
parsing a macro language expression to identify a new keyword in the macro language expression that is not within the plurality of keywords in the predefined macro language;
retrieving, from a registry of keywords and associated executable codes, an executable code associated with the new keyword identified in the macro language expression, the executable code corresponding to a procedure not performed by the execution of the predefined macro language; and
executing the executable code retrieved from the registry to run the extended macro command associated with the new keyword in the macro language expression without recompiling the macro language, the executable code associated with the new keyword not included in the predefined macro language and resulting in the performance of a procedure not performed by execution of the predefined macro language alone.

Applicants submit that *Sakharov* does not disclose the combination of elements recited in Applicants' Claim 1.

1. **The cited references do not disclose “executing the executable code retrieved from the registry to run the extended macro command associated with the new keyword in the macro language expression without recompiling the macro language.”**

For example, *Sakharov* does not disclose, teach, or suggest “executing the executable code retrieved from the registry to run the extended macro command associated with the new keyword in the macro language expression without recompiling the macro language,” as recited in Applicants' Claim 1. Instead, *Sakharov* discloses that the programming language extensions are performed by preprocessors that turn code into a standard programming language prior to a compiler compiling the code. Specifically, *Sakharov* states:

Programming language extensions are easily defined with macro definitions. Compilers do not have to be changed to digest languages extended by means of macros. Instead, **preprocessors that turn code in an extended language into code in a standard programming language are built automatically.**

(*Sakharov*, page 65, paragraph 4, emphasis added). Thus, the preprocessor uses the macro definitions to extend the language as a preprocess to the compiler. Because *Sakharov* discloses that the language is extended before compiling, Applicants respectfully submit that *Sakharov* does not disclose, teach, or suggest “executing the executable code retrieved from the registry to run the extended macro command associated with the new keyword in the macro language expression without recompiling the macro language,” as recited in Applicants’ Claim 1.

2. **The cited references do not disclose “the executable code associated with the new keyword not included in the predefined macro language and resulting in the performance of a procedure not performed by execution of the predefined macro language alone.”**

As another example, *Sakharov* does not disclose, teach, or suggest “the executable code associated with the new keyword not included in the predefined macro language and resulting in the performance of a procedure not performed by execution of the predefined macro language alone,” as recited in Applicants’ Claim 1. Instead, *Sakharov* explicitly discloses that “[m]acro definitions intended for high-level languages should be specific to their respective base languages.” (*Sakharov*, page 59, paragraph 4). *Sakharov* further states that “[m]acros which are specific to the respective programming languages can be used as means for extending the languages.” (*Sakharov*, page 49, paragraph 5). Thus, while *Sakharov* allows a macro to provide new terminology, the new terminology can only be translated into the existing base language. Accordingly, *Sakharov* actually teaches away from Applicants’ claim element requiring that “the executable code associated with the new keyword [is] not included in the predefined macro language and resulting in the performance of a procedure not performed by execution of the predefined macro language alone.”

3. **The cited references do not disclose “retrieving, from the registry of keywords and associated executable codes, an executable code associated with the new keyword identified in the macro language expression, the executable code corresponding to a procedure not performed by the execution of the predefined macro language.”**

As still another example, *Sakharov* does not disclose, teach, or suggest “retrieving, from the registry of keywords and associated executable codes, an executable code associated with the new keyword identified in the macro language expression, the executable code corresponding to a procedure not performed by the execution of the predefined macro language,” as recited in Applicants’ Claim 1. In the *Office Action*, the Examiner acknowledges that the recited claim element is not disclosed in *Sakharov* but states that the claimed operation would have been obvious to one having ordinary skill in the art at the time of Applicants’ invention. (*Office Action*, page 4). Applicants respectfully disagree.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). The showing must be clear and particular. *See, e.g., C.R. Bard v. M3 Sys., Inc.*, 48 USPQ.2d 1225, 1232 (Fed. Cir. 1998). Further, it is essential to view the invention as a whole, taking each element into account as well as the advantages, properties, utilities, and results of the invention. *In re Chupp*, 816 F.2d 643, 2 U.S.P.Q.2d 1437 (Fed. Cir. 1987). “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert denied*, 469 U.S. 851 (1984); M.P.E.P. § 2141.02).

In this case, *Sakharov* explicitly discloses that “[m]acro definitions intended for high-level languages should be specific to their respective base languages.” (*Sakharov*, page 59, paragraph 4). *Sakharov* further states that “[m]acros which are specific to the respective programming languages can be used as means for extending the languages.” (*Sakharov*, page 49, paragraph 5). Thus, while *Sakharov* allows a macro to provide new terminology, the new terminology can only be translated into the existing base language. Accordingly, *Sakharov* actually teaches away from and, thus, leads away from Applicants’ claim element requiring that “the executable code [correspond] to a procedure not performed by the execution of the predefined macro language.” As purported motivation for the proposed modification, the Examiner states that “it is well known in the art that the C language itself has a registry of 33 keywords with the keywords being used in the source code and compiling of the macro language.” (*Office Action*, page 4). However, providing a registry of keywords

that are used in the base source code also teaches away from Applicant's claim element requiring that "the executable code [correspond] to a procedure not performed by the execution of the predefined macro language." Because *Sakharov* teaches away from Applicants' claimed operations and because the motivation provided by the Examiner teaches away from Applicants' claimed operations, even with the benefit of the *Sakharov* disclosure, it would not have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the disclosure of *Sakharov* to include "retrieving, from the registry of keywords and associated executable codes, an executable code associated with the new keyword identified in the macro language expression, the executable code corresponding to a procedure not performed by the execution of the predefined macro language," as recited in Applicants' Claim 1.

4. Conclusion

For at least the reasons discussed above, Applicants respectfully request reconsideration and allowance of independent Claim 1, together with Claim 2 that depends from Claim 1. For analogous reasons, Applicants also request reconsideration and allowance of independent Claim 9.

B. **Claims 3, 4, 6, and 10-21 are patentable over the proposed *Sakharov-Brooks-Greenfeld-McIlroy-Nguyen* Combination**

In response to the Examiner's rejection of Claims 3, 4, 6, and 10-21 under the proposed *Sakharov-Brooks-Greenfeld-McIlroy-Nguyen* combination, Applicants submit that the references, whether considered alone or together, do not disclose, teach, or suggest the combination of elements recited in Applicants' Claims 3, 4, 6, and 10-21.

For example, independent Claim 3 of the present Application, as amended, recites:

A system for providing an extensible macro language, comprising:
a macro handler operable to maintain a predefined macro language comprising a plurality of keywords and a plurality of associated commands for execution;

a parser operable to parse a macro language expression to identify a new keyword in the macro language expression that is not within the

plurality of keywords in the predefined macro language;

a registry of keywords and associated executable codes, including one or more keywords and one or more executable codes that are not included in the predefined macro language, each keyword being associated with a respective one of the executable codes, each executable code corresponding to a procedure not performed by the execution of the predefined macro language; and

wherein the macro handler is further operable to receive the new keyword from the parser, retrieve, from the registry of keywords and associated executable codes, the executable code associated with the new keyword identified within the macro language expression, and execute the retrieved executable code to run the extended macro command associated with the new keyword without recompiling the macro language, the executable code associated with the new keyword not included in the predefined macro language and resulting in the performance of a procedure not performed by execution of the predefined macro language alone.

Applicants submit that the proposed *Sakharov-Brooks-Greenfeld-McIlroy-Nguyen* combination does not disclose, teach, or suggest the particular combination of elements and operations recited in Applicants' Claim 3.

1. *Sakharov* is not relied upon to reject Claim 3.

Initially, Applicants note that although the Examiner states that Claim 3 is rejected over *Sakharov* in view of *Brooks*, *Greenfeld*, *McIlroy*, and *Nguyen*, the Examiner identifies no elements of Claim 3 as actually being disclosed by *Sakharov*. Rather, the Examiner explicitly identifies all of the claim elements recited in Claim 3 as **not** being disclosed in *Sakharov*. Because *Sakharov* is not relied upon to reject any claim element of Claim 3, Applicants have not addressed *Sakharov* below. However, Claim 3 recites certain claim elements that are similar to those discussed above with regard to Claim 1. Accordingly, Applicants submit that *Sakharov* is deficient with regard to Applicants' claim elements for reasons similar to those discussed above with regard to Claim 1.

2. The cited references do not disclose "a parser operable to parse a macro language expression to identify a new keyword in the macro language expression that is not within the plurality of keywords in the predefined macro language."

As further examples of the deficiencies of the proposed *Sakharov-Brooks-Greenfeld-McIlroy-Nguyen* combination, the cited references do not disclose, teach, or suggest “a parser operable to parse a macro language expression to identify a new keyword in the macro language expression that is not within the plurality of keywords in the predefined macro language,” as recited in Claim 3. In the *Office Action*, the Examiner explicitly relies upon *Greenfeld* for disclosure of the recited claim elements. Applicants respectfully disagree.

The cited portions of *Greenfeld* merely disclose that a parser 42 “takes as input the formal grammar 56 of the target language, and a source code skeleton 60, 62 of each of the programs supporting the lexical scanner 40 and the parser 42.” (*Greenfeld*, Column 8, lines 8-13). “The generator 58 then produces the source code for a lexical scanner and a parser tailored to or customized for the particular target language described by the formal grammar 56. That is, the grammar 56 describes legal sentences in the target language and the parser 42 is generated to exactly analyze those sentences.” (*Greenfeld*, Column 8, lines 13-19). Thus, although *Greenfeld* discloses a parser, the parser of *Greenfeld* merely operates to provide source code analysis to perform error checking. (*Greenfeld*, Column 8, lines 19-38; see also Abstract). In related disclosure, *Greenfeld* specifically states that “[t]he analysis member operates according to the programming language of the source code as defined by a grammar mechanism.” (*Greenfeld*, Abstract). Accordingly, the parser of *Greenfeld* is limited to the particular target language described in the grammar of the source code. The parser of *Greenfeld* is not operable to “identify a new keyword in the macro language expression that is not within the plurality of keywords in the predefined macro language,” as recited in Applicants’ Claim 3.

3. The cited references do not disclose a macro handler operable to “execute the retrieved executable code to run the extended macro command associated with the new keyword without recompiling the macro language.”

As another example, Applicants respectfully submit that the cited references do not disclose, teach, or suggest a macro handler operable to “execute the retrieved executable code to run the extended macro command associated with the new keyword without recompiling the macro language,” as recited in Applicants’ Claim 3. In the *Office Action*, the Examiner

explicitly relies upon *Brooks* for disclosure of the recited claim elements. Applicants respectfully disagree.

Brooks relates to a “programmable controller 10” that a user programs “via terminal 11 which is a personal computer that executes an editor program for authoring a ladder logic control program.” (*Brooks*, Column 6, lines 36-39). As disclosed in *Brooks*, a user programs the ladder logic control program, and an “editor program then converts the ladder diagram into operation codes (opcodes) and operand addresses which can be executed by the processor module 20.” (*Brooks*, Column 6, lines 39-46). Applicants respectfully submit that the conversion of the ladder diagram into opcodes is, in fact, analogous to compiling the ladder logic control program. The cited portions of *Brooks* support such a conclusion. For example, *Brooks* discloses that “[w]hen program development software in the terminal 11 translates the ladder diagram into instructions **for execution by the processor module 20**, a unique operation code (opcode) is assigned to each macro instruction name used in the program.” (*Brooks*, Column 8, lines 25-29, emphasis added). Thus, while *Brooks* discloses that a “macro directory 61 is scanned by ladder logic processor 39 to locate the entry for the opcode of the macro instruction” (*Brooks*, Column 9, lines 2-7), the opcode is the product of recompiling or converting the ladder diagram into machine readable code. Accordingly, Applicants respectfully submit that *Brooks* is limited to a system that does require the recompiling of the macro language. *Brooks* and, thus, the *Sakharov-Brooks-Greenfeld-McIlroy-Nguyen* combination does not disclose, teach, or suggest a macro handler operable to “execute the retrieved executable code to run the extended macro command associated with the new keyword without recompiling the macro language,” as recited in Applicants’ Claim 3.

4. **The cited references do not disclose a macro handler operable to “execute the retrieved executable code to run the extended macro command associated with the new keyword . . . the executable code associated with the new keyword not included in the predefined macro language and resulting in the performance of a procedure not performed by execution of the predefined macro language alone.”**

As another example, the proposed *Sakharov-Brooks-Greenfeld-McIlroy-Nguyen* combination does not disclose, teach, or suggest a macro handler operable to “execute the retrieved executable code to run the extended macro command associated with the new keyword . . . **the executable code associated with the new keyword not included in the predefined macro language and resulting in the performance of a procedure not performed by execution of the predefined macro language alone,**” as recited in Claim 3. In the *Office Action*, the Examiner explicitly relies upon *Brooks* for disclosure of the recited claim elements.

As discussed above, *Brooks* relates to a “programmable controller 10” that a user programs “via terminal 11 which is a personal computer that executes an editor program for authoring a ladder logic control program.” (*Brooks*, Column 6, lines 36-39). As disclosed in *Brooks*, a user programs the ladder logic control program, and an “editor program then converts the ladder diagram into operation codes (opcodes) and operand addresses which can be executed by the processor module 20.” (*Brooks*, Column 6, lines 39-46). Applicants respectfully submit that the conversion of the ladder diagram into opcodes is, in fact, analogous to compiling the ladder logic control program and, thus, the ladder logic control program and opcodes are, in fact, procedures performed by execution of the predefined macro language alone. For example, *Brooks* discloses that “[w]hen program development software in the terminal 11 translates the ladder diagram into instructions for execution by the processor module 20, a unique operation code (opcode) is assigned to each macro instruction name used in the program.” (*Brooks*, Column 8, lines 25-29). The cited portion indicates that at the time the application is created (i.e., when the macro commands are written by the user and converted into opcodes), the application includes all possible macros and then assigns opcodes to them. Were a new macro command discovered, there would be no associated opcode assigned to it and, thus, no way to run the macro command. Accordingly, Applicants respectfully submit that *Brooks* is limited to the procedures performed by the predefined macro language. *Brooks* and, thus, the *Sakharov-Brooks-Greenfeld-McIlroy-Nguyen* combination does not disclose, teach, or suggest a macro handler operable to “execute the retrieved executable code to run the extended macro command associated with the new keyword . . . **the executable code associated with the new keyword not included in the predefined macro language and resulting in the performance of a procedure not**

performed by execution of the predefined macro language alone,” as recited in Applicants’ Claim 3.

5. **The cited references do not disclose “a registry of keywords and associated executable codes that are not included in the predefined macro language . . . each executable code corresponding to a procedure not performed by the execution of the predefined macro language.”**

As further examples of the deficiencies of the proposed *Sakharov-Brooks-Greenfeld-McIlroy-Nguyen* combination, the cited references do not disclose, teach, or suggest “a registry of keywords and associated executable codes that are not included in the predefined macro language . . . each executable code corresponding to a procedure not performed by the execution of the predefined macro language,” as recited in Claim 3. In the *Office Action*, the Examiner explicitly relies upon *Nguyen* for disclosure of the recited claim elements. Applicants respectfully disagree. *Nguyen* merely discloses that a “macro language contains directives, which are reserved keywords with a prefix symbol “%” (e.g., % SQL). (*Nguyen*, Column 6, lines 7-8). Thus, *Nguyen* relates to a predefined macro language that includes directives. Because *Nguyen* specifies that the macro language is comprised of “reserved keywords,” *Nguyen* does not at all relate to a registry of keywords “a registry of keywords and associated executable codes **that are not included in the predefined macro language,**” as recited in Claim 3. Additionally, there is no disclosure in *Nguyen* that “each executable code corresponding to a procedure not performed by the execution of the predefined macro language,” as recited in Claim 3.

6. Conclusion

For at least the reasons discussed above, Applicants respectfully request reconsideration and allowance of Claim 3, together with Claims 4, 6, and 14-17 that depend on Claim 3.

Claims 10-13 and 18-21 depend on Claims 1 and 9, respectively. Accordingly, dependent Claims 10-13 and 18-21 are not obvious over the proposed *Sakharov-Brooks-Greenfeld-McIlroy-Nguyen* combination at least because Claims 10-13 and 18-21 include the

limitations of their respective independent claims, which Applicants have shown above to be allowable. Since Claims 10-13 and 18-21 incorporate the limitations of their respective independent claims, Applicants have not provided detailed arguments with respect to Claims 10-13 and 18-21. However, Applicants remain ready to do so if it becomes appropriate. Applicants respectfully request reconsideration and allowance of Claims 10-13 and 18-21.

C. The Proposed *Sakharov-Brooks-Greenfeld-McIlroy-Nguyen* Combination is Improper as Applied to Claims 3, 4, 6, and 10-21

Furthermore, Applicants continue to submit that the Examiner has not provided the requisite teaching, suggestion, or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of Applicant's invention to modify or combine the cited references. The proposed *Sakharov-Brooks-Greenfeld-McIlroy-Nguyen* combination is improper for at least these reasons.

1. The Legal Standard

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention. It is clear based at least on the many distinctions discussed above that the proposed *Sakharov-Brooks-Greenfeld-McIlroy-Nguyen* combination does not, taken as a whole, suggest the claimed invention, taken as a whole. Applicants respectfully submit that the Examiner has merely pieced together disjointed portions of references, with the benefit of hindsight using Applicants' claims as a blueprint, in an attempt to reconstruct Applicants' claims.

The controlling case law, rules, and guidelines repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "The tendency to resort to 'hindsight' based upon applicant's disclosure is

often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” M.P.E.P. § 2142.

The U.S. Supreme Court’s recent decision in *KSR Int’l Co. v. Teleflex, Inc.* reiterated the requirement that Examiners provide an explanation as to why the claimed invention would have been obvious. *KSR Int’l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727 (2007). The analysis regarding an apparent reason to combine the known elements in the fashion claimed in the patent at issue “should be made explicit.” *KSR*, 127 S.Ct. at 1740-41. “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.* at 1741 (internal quotations omitted).

The new examination guidelines issued by the United States Patent and Trademark Office (“PTO”) in response to the *KSR* decision further emphasize the importance of an explicit, articulated reason why the claimed invention is obvious. Those guidelines state, in part, that “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” *Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57526, 57528-29 (Oct. 10, 2007) (internal citations omitted). The guidelines further describe a number of rationales that, in the PTO’s view, can support a finding of obviousness. *Id.* at 57529-34. The guidelines set forth a number of particular findings of fact that must be made and explained by the Examiner to support a finding of obviousness based on one of those rationales. *See id.*

2. The Analysis

To maintain the rejections of Claims 3, 4, 6, and 10-21 the Examiner cites disjointed portions of four unrelated references. For example, with respect to independent Claim 3, the Examiner acknowledges that *Sakharov* fails to disclose each element of the claimed invention but relies upon *Brooks* for disclosure of a “macro handler” operable to perform certain

claimed operations, *Greenfeld* for disclosure of “a parser” operable to perform certain claimed operations, and *Nguyen* for disclosure of “a registry of keywords and associated executable codes.” Applicants respectfully submit that the Examiner’s attempt to modify or combine *Sakharov* with *Greenfeld*, *Nguyen*, *McIlroy*, and/or *Brooks* appears to constitute the type of impermissible hindsight reconstruction of Applicants’ claims, using Applicants’ claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.¹ Applicants respectfully submit that the Examiner’s reliance on disjointed portions of five unrelated references evidences such use of hindsight to reconstruct Applicants’ claims.

The mere fact that four, and in some instances five, references must be combined to disclose the claim elements disclosed in a single one of Applicants’ claims provides evidence that the overall combination of claim elements claimed by Applicants would not have been obvious to one of ordinary skill in the art at the time of Applicants’ invention. Even if *Greenfeld* discloses “a parser” operable to perform Applicants’ claimed operations (which Applicants do not admit and expressly disputes above), *Nguyen* discloses a “registry of keywords and associated executable codes” (which Applicants do not admit and expressly disputes above), *McIlroy* discloses recognizing one or more tokens in the macro language expression, and *Brooks* discloses “a macro handler” operable to perform Applicants’ claimed operations (which Applicants do not admit and expressly disputes above), such a piecemeal rejection of Applicants’ claims fail to give credence to each element of Appellants’ claims and to the overall combination of features recited in the claims. For these reasons, Applicants submit that a rejection of Claims 3, 4, and 6 under the proposed *Sakharov-Brooks-Greenfeld-McIlroy-Nguyen* combination, in the manner provided by the Examiner, is improper and can only result from the piecing together of disjointed portions of unrelated references to reconstruct Applicants’ claims.

Furthermore, Applicants note that in the *Office Action* the Examiner identifies no suggestion or motivation for modifying the teachings of *Sakharov* to include the disclosure of

¹ It is improper for an Examiner to use hindsight having read the Applicant’s disclosure to arrive at an obviousness rejection. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). It is improper to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

Greenfeld. Similarly, the Examiner identifies no suggestion or motivation for modifying the teachings of *Sakharov* to include the disclosures of *Nguyen*. The Examiner merely provides a purported motivation for combining the disclosure of *Sakharov* with the disclosure of *Brooks*. There is no discussion whatsoever in the *Office Action* relating to the suggestion or motivation for modifying the teachings of *Sakharov* to include the disclosures of *Greenfeld* and *Nguyen*. Stated differently, the Examiner has provided no evidence of motivation or suggestion that could support a conclusion that one of ordinary skill in the art at the time of Applicants' invention would have been motivated to modify the disclosure of *Sakharov* to include the cited disclosures of *Greenfeld* and *Nguyen*.² In other words, the alleged advantage of the system proposed by the Examiner does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicants' invention (*without using Applicants' claims as a guide*) to modify the particular techniques disclosed in *Sakharov* with the cited disclosures in *Greenfeld* and *Nguyen*; (2) how one of ordinary skill in the art at the time of Applicants' invention would have actually done so; and (3) how doing so would purportedly meet the limitations of Applicants' independent claims. Applicants respectfully submit that the proposed *Sakharov-Brooks-Greenfeld-McIlroy-Nguyen* is deficient on its face for at least these reasons.

With regard to the additional disclosure of *Brooks*, the Examiner states:

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify in *Sakharov* the teachings of *Brooks* because such a modification is well known in the art and would enhance *Sakharov's* extended keywords with the parser receiving the keyword first, then parsing the expression and the macro handler in response saving the previous contents of the processor registers (keywords) during execution of the main program with the user selecting the functions and submitting the macro command to run the code associated with the keywords with a prefix symbol.

² To the extent that the Examiner continues to rely on "common knowledge" or "well known" art in support of his rationale for combining the references, the Examiner is requested to produce a reference in support of his position pursuant to M.P.E.P. § 2144.03. If the Examiner is relying on personal knowledge to supply the required motivation or suggestion to combine, Applicants respectfully request that the Examiner produce an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

(*Office Action*, pages 7-8). Thus, again, the Examiner has not pointed to any portions of the cited references that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to incorporate the disclosure of *Sakharov* with the cited disclosure of *Brooks*.³ The Examiner's speculation that such a modification "is well known in the art" does not meet the standard required for an obvious combination of references. The Examiner's bald assertion that it is well known in the art and the Examiner's assertion that such a modification would enhance *Sakharov*'s extended words does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicants' invention (*without using Applicants' claims as a guide*) to modify the particular techniques disclosed in *Sakharov* with the cited disclosure in *Brooks*; (2) how one of ordinary skill in the art at the time of Applicants' invention would have actually done so; and (3) how doing so would purportedly meet the limitations of Applicants' independent claims. Indeed, if it were sufficient for Examiners to merely point to an advantage purported to be "well known in the art" and conclude that it would have been obvious to combine of modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable. Of course, as the Federal Circuit has made clear and as discussed above, that is not the law.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 3, 4, 6, and 10-21.

New Claim 22 is Allowable over the Cited References

New Claim 22 has been added and is fully supported by the original specification. No new matter has been added. New Claim 22 depends upon independent Claim 1, which Applicants have shown above to be allowable. Claim 22 is not obvious over *Sakharov*, whether considered alone or in combination with any other cited reference, because Claim 22

³ To the extent that the Examiner continues to rely on "common knowledge" or "well known" art in support of his rationale for combining the references, the Examiner is requested to produce a reference in support of his position pursuant to M.P.E.P. § 2144.03. If the Examiner is relying on personal knowledge to supply the required motivation or suggestion to combine, Applicants respectfully request that the Examiner produce an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

includes the limitations of independent Claim 1 and adds additional elements that further distinguish the art.

For example, Claim 22 recites “wherein the executable code retrieved from the registry to run the extended macro command associated with the new keyword in the macro language expression is executed without modifying the source code of the macro language.” The recited claim element would not be obvious in view of the disclosure of *Sakharov* since *Sakharov* specifically discloses programs that “serve to modify specifications of the **source programming language**.” (*Sakharov*, page 65, paragraph 1, emphasis added). *Sakharov* discloses:

One of [the programs] modifies the lex specifications of the language. The other transforms the yacc specifications. They are separated from the program that creates preprocessors because modifications of the lex and yacc specifications **of the source language** need to be done once for any given language. We use lex and yacc to parse and modify the yacc specifications **of the source programming language**. The syntax of yacc specification in the form of yacc rules is given in [12]. The program that modifies the lex specifications **of the source language** is implemented in C.

(*Sakharov*, page 65, paragraph 1, emphasis added). Because *Sakharov* explicitly discloses that the underlying source programming language is modified, *Sakharov* does not disclose, teach, or suggest “wherein the executable code retrieved from the registry to run the extended macro command associated with the new keyword in the macro language expression is executed without modifying the source code of the macro language,” as recited in Applicants’ Claim 22. Because the disclosures of *Brooks*, *McIlroy*, *Greenfeld*, and *Nguyen* do not cure these deficiencies, Applicants respectfully submit that new Claim 22 is allowable over the prior art of record.

For at least these reasons, Applicants request consideration and allowance of new dependent Claim 22.

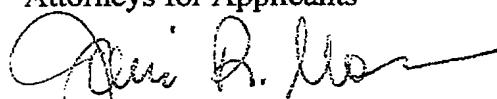
CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other apparent reasons, Applicants respectfully request full allowance of all pending Claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Applicants believe no fee is due. However, should there be a fee discrepancy, the Commissioner is hereby authorized to charge any required fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicants



Jenni R. Moen
Reg. No. 52,038
Phone: (214) 953-6809

Date: July 31, 2008

CORRESPONDENCE ADDRESS:

at Customer Number: **05073**